

03-01-06

EXPRESS MAIL NO. EV741783709US



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Simone Sassolini et al.
Application No. : 10/821,263
Filed : April 8, 2004
For : METHOD FOR MANUFACTURING A MICRO-ELECTRO-MECHANICAL DEVICE, IN PARTICULAR AN OPTICAL MICROSWITCH, AND MICRO-ELECTRO-MECHANICAL DEVICE THUS OBTAINED

Examiner : George R. Fourson III
Art Unit : 2823
Docket No. : 854063.748
Date : February 28, 2006

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents:

In response to the Restriction Requirement dated December 29, 2005, please extend the period of time for response one month, to expire on February 28, 2006. Enclosed are a Petition for an Extension of Time and the requisite fee.

Applicants hereby elects Species I, with traverse, for examination at this time. Based upon the Examiner's analysis, claims 1-12 fall within Species I. However, applicants disagree with this analysis for reasons set forth below.

Applicants respectfully traverse the restriction requirement on the grounds that the Examiner has not met the burden of showing, a) that the species are independent or distinct, and b) why there would be a serious burden on the Examiner if restriction is not required (see MPEP § 808).

In defining species I the Examiner has cited the step of: “bonding and forming, after the bonding step, second supporting parts and second operative parts,” and points to claim 1 as an example. In defining Species II, as distinct from Species I, the Examiner has cited the step of: “removing anchor regions to make a rotor region free,” and points to claim 14 as an example. The Examiner does not state why the claimed inventions are independent or distinct, but it appears to the applicants that the Examiner’s position is that the claims are directed to mutually exclusive species. In this regard, MPEP § 806.04(f) states,

Where two or more species are claimed, a requirement for restriction to a single species may be proper if the species are mutually exclusive. Claims to different species are mutually exclusive if one claim recites limitations disclosed for a first species but not a second, while a second claim recites limitations disclosed only for the second species and not the first. This may also be expressed by saying that to require restriction between claims limited to species, the claims must not overlap in scope.

(Emphasis added.)

Thus, for example, for claims 1 and 14 to be restricted to separate species, they must not only each include at least one limitation that is not found in the other claim, but the disclosure of the specie on which claim 1 reads cannot disclose the exclusive limitation recited in claim 14, and vice-versa. Therefore, if any one of the disclosed embodiments can be shown to include all the limitations of both claims, those two claims cannot be restricted as separate species.

The specification describes in detail a method of manufacturing a MEMS device. Applicants call the Examiner’s attention to the specification at page 8, lines 23 and 24 of the specification, which states, “As illustrated in Figure 13, the first wafer 1 and the second wafer 32 are then bonded to one another.” The bonding step of claim 1 may be read on this passage.

At page 9, lines 22-25, the specification states, “second external supporting frame 47, which is fixed, and moving supporting parts, in particular, an inner frame 48 and a platform 50, are formed. Furthermore, first, second, third and fourth rotating assemblies 51-54 are formed.” The second supporting parts and second operative parts of claim 1 may be read on this passage, which is described as following the bonding step, as recited in claim 1.

Finally, at page 11, lines 8, 9, 21, and 22, the specification states, “the dielectric layer 7 is removed where exposed, while the sacrificial anchoring regions 9 are completely

removed Owing to the removal of the sacrificial anchoring regions 9, the inner frame 48 and the platform 50 are freed and are hence movable." The step of removing anchor regions to make a rotor region free, of claim 14, can be read on this passage.

Each of the above cited passages is found in the description of the same embodiment of the invention. Accordingly, restriction between claims that read on that embodiment is improper, at least on the basis of mutual exclusivity. This is true, even though the claims may also read on other, distinct embodiments.

With regard to the second requirement, MPEP § 808.02 states,

Where the related inventions as claimed are shown to be independent or distinct under the criteria of MPEP § 806.05(c) - § 806.06, the examiner, in order to establish reasons for insisting upon restriction, must explain why there would be a serious burden on the examiner if restriction is not required.

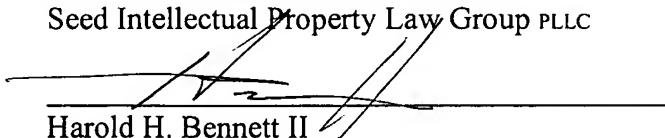
...

Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among independent or related inventions.

(Emphasis added.)

The Examiner has not provided any basis to support a position that it would be a serious burden to examine all of claims 1-12 and 13-17, together. Accordingly, applicants respectfully request reconsideration and withdrawal of the Restriction Requirements, and favorable consideration of claims 1-12 and 13-17.

Respectfully submitted,
Seed Intellectual Property Law Group PLLC



Harold H. Bennett II
Registration No. 52,404

HHB:wt

Enclosure:
Postcard

701 Fifth Avenue, Suite 6300
Seattle, Washington 98104-7092
Phone: (206) 622-4900
Fax: (206) 682-6031
736436_1.DOC